



W  
AF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : David D. Koester et al.

Appeal No. \_\_\_\_\_

Serial No.: 09/751,669

Filed : December 29, 2000

Group Art Unit: 2652

For : MACHINING ACTUATOR PERIPHERY  
TO REDUCE RESONANCE VARIATION

Examiner: Tianjie  
Chen

Docket No.: S01.12-0697/STL 9565

**REPLY BRIEF FOR APPELLANT**

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

I HEREBY CERTIFY THAT THIS PAPER IS  
BEING SENT BY U.S. MAIL, FIRST CLASS,  
TO THE COMMISSIONER OF PATENTS AND  
TRADEMARKS, WASHINGTON, D.C. 20231,  
THIS

31 DAY OF July, 2006  
*Don h. K.*  
PATENT ATTORNEY

Sir:

This is in reply to the new issues raised in the Examiner's  
Answer dated May 31, 2006.

**GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

The Examiner's Answer indicates that the Examiner  
elects only two of the four final rejections under 35 U.S.C. §102  
for review on appeal.

Applicants briefed all rejections and are entitled to  
review of all rejections in a single appeal.

Therefore, the non-elected rejections are overcome and  
withdrawn with prejudice since such rejections cannot be reserved  
for a later action following appeal. MPEP §1214.07. Such  
rejections would be subject to *res judicata*.

**ARGUMENT**

I. WILLIAMS ET AL. DO NOT DISCLOSE A PRODUCT IDENTICAL TO  
OR ONLY SLIGHTLY DIFFERENT THAN THAT OF CLAIM 13

This is in response to the Examiner's statements in the  
paragraph labeled "Argument I.A.:"

As addressed in Applicants' brief, the "machined

external peripheral surface" recited in claim 13 is a positively recited structural element, not a product by process element.

Regardless, the resulting product disclosed by Williams et al. is not identical to or slightly different than that recited in claim 13, as alleged by the Examiner.

Claim 13 requires "an actuator with a machined external peripheral surface extending along an entire periphery of the actuator and comprising a desired profile dimension entirely defined by the machined external peripheral surface."

The Examiner's Answer incorrectly suggests that "the difference between the micro grooves generated by machining and [the] dull smooth surface generated by cast or extruding plays no role in meeting the claimed feature of 'comprising a desired profile dimension.'" The Examiner thus concludes that, "the difference between micro-grooves and [the] dull, smooth surface should be considered as 'slightly different' . . . ."

In contrast, the machined external surface in claim 13 is significantly different than a cast or extruded surface such as that disclosed by Williams et al.

As described in Applicants' specification, the typical processes of casting and extruding actuators inherently have profile tolerances that result in significant variation in arm resonance from actuator to actuator. (Page 3, lines 4-19).

A profile dimension that is defined entirely by a machined external peripheral surface allows the profile dimension to have a lower tolerance than if the dimension is simply defined by an extruded or molded surface. The precise profile dimension of the surface can therefore be achieved with greater accuracy and greater certainty. When manufacturing a group of similar actuators, there will be less variance in the profile dimensions from one actuator to the next. This results in a reduced degree of variance in the resonance characteristics from one actuator to the next. (Page 9, line 16 to page 10, line 3).

Thus, the "machined external peripheral surface" element recited in claim 13 is significantly different than that disclosed by Williams et al.

II. THE REJECTION OF CLAIM 13 BASED ON WOOD ET AL. IS WITHDRAWN

This is in response to the Examiner's statements in the paragraph labeled "Argument II."

The Examiner elected not to present the rejection based on Wood et al. for review by the Board. The Examiner then concludes that Applicants' "Argument II is escaped."

The argument is not "escaped" or otherwise avoided by failing to brief the rejection. Rather, the failure to brief a rejection must be interpreted to mean that the rejection has been withdrawn with prejudice and subject to *res judicata* following appeal.

III. REJECTION BASED ON BORN ET AL.

This rejection was addressed in Applicants' brief.

IV. THE REJECTION OF CLAIM 13 BASED ON HYDE ET AL. IS WITHDRAWN

This is in response to the Examiner's statements in the paragraph labeled "Argument IV."

The Examiner elected not to present the rejection based on Hyde et al. for review by the Board. The rejection based on Hyde et al. has therefore been overcome and withdrawn with prejudice.

V. THE REJECTION OF CLAIMS 17 AND 18 UNDER §103(a) SHOULD BE REVERSED

The Examiner's Answer acknowledges that Williams et al./Wood et al./Born et al./Hyde are silent on the tolerance of the dimension of the surface but suggests this tolerance would be obvious in view of Brar et al.

However, as discussed above, Williams et al./Wood et al./Born et al./Hyde fail to teach or suggest a machined external

surface extending along an entire periphery of an actuator. Therefore even if the teachings of Brar et al. were combined with those of Williams et al./Wood et al./Born et al./Hyde, the resulting combination would still fail to teach or suggest all of the elements of dependent claims 17 and 18, including the elements of independent claim 13. Accordingly, Applicants respectfully request that the rejection of claims 17 and 18 under §103(a) be reversed.

**CONCLUSION**

Applicants respectfully request that the Board reverse the claim rejections and find that claims 13 and 17-18 are in condition for allowance.

WESTMAN, CHAMPLIN & KELLY, P.A.

By: 

David D. Brush, Reg. No. 34,557  
Suite 1400 - International Centre  
900 Second Avenue South  
Minneapolis, Minnesota 55402-3319  
Phone: (612) 334-3222 Fax: (612) 334-3312

DDB: